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**Patent and Trademark Office**

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08/838,548	04/09/97	GINES	D PC9743ALP

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EXAMINER

MANTIS MERCADER, E

ART UNIT

PAPER NUMBER

3737

DATE MAILED:

02/18/99

#9

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/838,548**

Applicant(s)  
**Gines**

Examiner  
**Eleni Mantis Mercader**

Group Art Unit  
**3737**



☒ Responsive to communication(s) filed on Nov 25, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-9 and 11-25 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-9 and 11-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **FINAL ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on 11/25/98 have been fully considered but they are not persuasive. Nardella'896 teaches the use of the electrosurgical energy preferably in the radiofrequency range. According to the international radiofrequency bands 3 kHz is the lowest limit of radiofrequency, and therefore the use of 100 kHz to indicate frequencies lower than radiofrequencies is confusing. The specification does not set forth the range of frequencies that applicant considers as radiofrequencies and therefore the limitation of the "output power occurs at a frequency lower than that of radio frequencies" is not enabling. Also, artisans such as Strul et al.'681 disclose a range of radiofrequencies ranging from 250-1000 kHz. If this is the case applicant has not disclosed the frequencies of 101-250 kHz and therefore the limitation of "frequency lower than that of radio frequencies" broadens the range of frequencies originally disclosed which constitutes new matter as there is no support of such a limitation in the specification.

Please note that Nardella states "preferably this electrosurgical energy is in radio frequency range." This does not preclude one skilled in the art from using frequencies lower than that of radio frequencies. Also, according to the international radiofrequency bands, the lower radio frequency listed is 3 kHz which is less than the 100 kHz frequency disclosed by applicant.

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*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9 and 11-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for using the frequencies of less than 100 kHz, does not reasonably provide enablement for using frequencies of 101-250 kHz. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Artisans such as Strul et al.'681 disclose a range of radiofrequencies ranging from 250-1000 kHz. If this is the case applicant has not disclosed the frequencies of 101-250 kHz and therefore the limitation of "frequency lower than that of radio frequencies" does not enable one skilled in the art to use the invention.

4. Claims 1-9 and 11-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation of "frequency lower than that of radio frequencies" was not disclosed in the specification or claims as originally filed.

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1-9 and 11-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Nardella'896.

Nardella'896 discloses an electrosurgical generator for applying out put power to a load having an electrical impedance, the electrosurgical generator comprising:

an impedance measurement circuit electrically connected to the load for producing a measure indicative of the electrical impedance; an RF output stage connected to the load for applying output power to the load, the RF output stage having an input for adjusting the value; and a power controller electrically connected to the measurement circuit and electrically connected to the input, wherein the controller has means for changing the electrical impedance by adjusting the input in response to the measure (col. 10, lines 16-45, claim 1). It is inherent that by the power control means changing the electrical impedance by adjusting the input in response to the measure, it in effect induces oscillations of the electrical impedance.

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Please note that Nardella states “preferably this electrosurgical energy is in radio frequency range.” This does not preclude one skilled in the art from using frequencies lower than that of radio frequencies. Also, according to the international radiofrequency bands, the lower radio frequency listed is 3 kHz which is less than the 100 kHz frequency disclosed by applicant.

### *Conclusion*


7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is (703) 308-0899. The examiner's supervisor, Mr. Marvin Lateef, can be reached on (703) 308-3256.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. The fax phone number for this group is (703) 305-3590.

  
Marvin M. Lateef  
Supervisory Patent Examiner  
Group 3700



EMM  
February 11, 1999.